

#13

1/6/9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Steven H. Rice	)	Art Unit:	2837
Serial No.	09/814,581	)	Examiner:	Hsieh, S.
Filed:	March 21, 2001	)	Cust. No.	22931
For:	METHOD AND APPARATUS	)	Attorney	
	FOR A DEVICE TO CREATE	)	Ref. No.:	P313641
	A MUSICAL NOISE			

MAIL STOP AMENDMENT  
(Sent via Private PAIR online)  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Certificate of Filing online (37 CFR 1.8a)

I hereby certify that this document (along with any document referred to as being attached or enclosed) is being transferred to the USPTO via Private PAIR, on date shown below.

January 6, 2009

\_\_\_\_\_/Stephanie Brown/  
Stephanie Brown

**RENEWED PETITION UNDER 37 CFR 1.137(b)**

Sir:

This is in response to the letter mailed on November 6, 2008 dismissing the renewed petition. This is a request for reconsideration. If any additional fees are required that were not submitted at the time of filing of this Response on the PAIR system, please charge them to Deposit Account No. 08-3260.

Please amend the above identified application as follows:

## REMARKS

This response is intended to account for the entire delay pursuant to 37 CFR 1.137(b). In particular, the two periods in question are the delay in the reply to result in the abandonment, and the delay in the initial Petition for Revival. Enclosed herein is a detailed account of as many facts as are attainable as to the time period up to the abandonment. After the abandonment, there was indeed a time delay before filing a revival application; however, the causal factor for this delay is very much related to the causal factor for the first delay. Namely, as described herein, the inventor's nephew was the stimulus for discovering a patent had not been issued.

The last response from the Examiner mailed November 6, 2008 is appreciated by the Applicant, and it is believed that all of the elements in that response are addressed herein. For convenience purposes, the Applicant's attorney will refer to various sections in the letter to ensure all questions put forth are addressed.

Referring now to the third page of the letter at the first partial paragraph, the Examiner noted in the last two sentences that there was a delay of 31 months in resuming prosecution. Further, the Examiner noted that the entire delay must be shown to the satisfaction of the Director to be unintentional. In general, discussed herein in greater detail, the nature and circumstance at the time of the abandonment will be described, and enclosed attachments include correspondence to the Applicant as well as Declarations. After the abandonment, the inventor was not sufficiently sophisticated in the nature of patent law, does not hold any patents, and did not understand the nature of maintenance fees or issue fees. As noted above, the status of the abandonment of the application was discovered by the Applicant's nephew, Jason Brewer.

The first full paragraph on the third page states in the second sentence that the renewed petition must identify the party having the right to reply to avoid abandonment. The party having the right to reply would be the inventor, Steven Rice. The last correspondence from the Patent and Trademark Office continues to state that this party, Steven Rice, must explain the efforts made to reply to the outstanding Office Action, and why no reply was filed. As recited in the previous correspondence, the period of time between August 17, 2002 and the date on which the Notice of Allowance was

mailed of May 21, 2002, was a rather difficult and adverse time for the Applicant. Described further in the last Declaration by Mr. Rice, he describes, in as much detail as he recalls, the medications he was taking for his back pain and the surrounding circumstance of how his wife, who was managing his affairs at the time, suffered a terminal illness and passed on.

Attached herewith as Attachment B is a correspondence from Mr. Rice's Physician's Assistant, Robert A. Morris. The second paragraph of Mr. Moore's correspondence states that Mr. Rice has been managing his pain since 1998, which has required opiates, physical therapy and referral a to Swedish Pain Clinic. The letter further discusses the specifics regarding the source of Mr. Rice's pain. Essentially, all indications are that he was not in a proper state of mind during these periods, and stated in his last Declaration in paragraph 4, Mr. Rice was under the mistaken belief least that he had successfully acquired a patent. Therefore, the prolonged delay from the abandonment of the application to the filing of the Petition to Revive is premised upon the mistaken belief by Mr. Rice that he had a patent, which eventually became apparent after his discussion with his nephew, Jason Brewer, some years later.

The final sentence in the first full paragraph on the third page of the last Patent and Trademark Office correspondence states that no effort was made to reply, and the party must explain why the delay did not result in a deliberate course of action (or inaction). The inaction of responding to the Office Action relates to the cognitive state of Mr. Rice during this time. It should be reiterated that the painkillers Mr. Rice was on were directly related to his injuries, and since this time Mr. Rice has attempted to take a holistic health approach and remove any dependency on painkillers to the degree possible. Described further herein is a detailed account as to the exchange between Mr. Robert Hughes and Mr. Rice during the first time period in question.

The second full paragraph of page 3 puts forth the question of who was the party having the right to reply to avoid abandonment on August 17, 2008. The person reviving the application is Mr. Steven Rice. The second sentence of this paragraph states that it is not clear to the Patent and Trademark Office whether the petition includes an explanation from Mr. Rice as to the efforts made to reply to the outstanding Office Action, and why no reply was filed. The next sentence states that specifics with regard

to certain time frames are not included in the last response or presented related to the Notice of Allowance mailed May 16, 2002. As shown in Attachment A, a letter was sent by U.S. Mail to Mr. Rice, which apparently followed a telephone conversation between Mr. Rice and Robert Hughes. A closer look at the Declaration of Robert Hughes stated what he remembers about this timeframe. As stated in Mr. Rice's Declaration, his mental state at the time was not fully functional, and therefore, specifics with regard to exact dates are not possible in his Declaration.

The last response did not include an explanation from the attorney of record at the time, Robert Hughes, because the previous petitions were generally focused around the reasons for the time delay, not the normal docketing and correspondence of the law firm, which did occur and were not the weak link in the chain of prosecution for getting the patent allowed. The final paragraph on the third page extending to the fourth page of the last correspondence from the Patent and Trademark Office indicates that no copies of any correspondence related to the filing or reply from Robert Hughes were included in the last response.

Therefore, there will now be a presentation of evidence related to all the links of the chain during the time frame up until the abandonment. In general, normal docketing and correspondence did occur, including letters and advice to the client Mr. Rice regarding tending to the Notice of Allowance of the patent application. Enclosed herewith as Attachment A is a copy of a letter sent to Steven Rice on June 14, 2002.

With regard to Period (2) beginning on page 4 in the first full paragraph of the last correspondence from the PTO, the case law states that the delay after an abandonment of an application cannot be deliberate when seeking revival of the application. That is, the delay in filing the reply and the Petition for Revival must have been intentional for the reply to not be accepted. It should be noted that a protracted delay (greater than a year) can trigger a request for additional information. In the present case, as stated by the inventor Mr. Rice, he was under the impression his patent eventually went through, as per his last Declaration. Therefore, there was no stimulus to take any action until his subsequent conversations with his nephew. As described in the first full paragraph on page 5 of the last Petitions Examiner correspondence, the Examiner requested statements required from persons at then Hughes and Schacht PLLC and responsible

persons having first-hand knowledge of the circumstances surrounding the protracted delay after the abandonment date.

Enclosed herewith is the declaration by Robert Hughes as well as the correspondence sent to Mr. Rice, enclosed herewith as Attachment A; however, the causal factor for not filing the issue fee was the action by Mr. Rice, and given Mr. Rice's statements regarding his cognitive state at the time, such an action was unintentional. The fact that Mr. Rice informed his nephew, Jason Brewer, that the application had matured into a patent also substantiates the claim that the actions were unintentional. Therefore, the delay with regard to Period (2) was caused by Mr. Rice's misunderstanding of the patent process, in that he did not feel that action was necessary to remedy the situation by way of filing a Petition to Revive because he was not aware of a problem. In other words, if a Petition to Revive, for example, were filed within a year of the abandonment, there would not be such detailed inquiry. In this present circumstance, it is granted that the Petition to Revive was filed much later than a year from the Notice of Abandonment; however, the reason for this prolonged delay is that Mr. Rice did not understand he did not have a patent and the Petition to Revive was later filed based upon the extra stimulus of Mr. Brewer's inquiry to Mr. Rice regarding the patent status. As stated in the previous declarations, Mr. Brewer then contacted Michael Hughes, and both Mr. Brewer and Mr. Rice were informed that Mr. Rice had not acquired an issued patent.

} not found  
in action?

If there is any matter which could be expedited by consultation with the Applicant's attorney, such would be welcome. The Applicant's undersigned attorney can normally be reached at the telephone number set forth below.

Signed at Bellingham, County of Whatcom, State of Washington this January 6, 2009.

Respectfully submitted,  
STEVEN H. RICE,

By\_\_\_\_/Michael Hughes/  
Michael Hughes, Reg. No. 41,084  
Hughes Law Firm, PLLC  
Pacific Meridian Plaza

4164 Meridian Street, Suite 302  
Bellingham, WA 98226  
(360) 647-1296  
Fax (360) 671-2489

ATTACHMENT A  
Serial Number 09/814,581  
Today's Date: January 6, 2009

ROBERT B. HUGHES

**LAW FIRM, PLLC**  
SIONAL LIMITED LIABILITY COMPANY

2001 Meridian Street, Suite 201  
BELLINGHAM, WA 98225  
(360) 647-1296  
1-888-647-1296  
FAX: (360) 671-2489

PATENT, TRADEMARK  
& COPYRIGHT LAW

June 14, 2002

Mr. Steven H. Rice  
3331 Bay Road  
Ferndale, WA 98248

Re: U.S. Patent S.N. 09/814,581  
File Name: METHOD AND APPARATUS FOR A DEVICE TO CREATE  
A MUSICAL NOISE  
Matter No: P313641

*Steve, I don't know to  
if you really want to  
pay this. This is a  
from letter we  
send and when  
we get the  
notice of  
allowance*

Dear Steven:

We are pleased to advise you that we have now received an official *Notice of Allowance and Fee(s) Due* in connection with the above-identified application. Copies are enclosed for your files.

The Issue Fee is due on or before **August 16, 2002**. The total billing for payment of the final fee, preparation of formal drawings, and advisory correspondence and handling related procedural matters will be **\$1,726.00**. Due to the fact that most of these costs are out-of-pocket, we kindly request a retainer in that amount in order to proceed with these final matters. For your convenience, we do accept VISA and MasterCard and you are invited to complete the authorization clause at the bottom of this letter.

**CAUTION:**

These costs are based on your qualifying for small entity status. A "Small Entity" is defined as any person, company, or other legal entity that has no more than 500 employees. To qualify for small entity, you must meet the following requirements:

- a) you, as owner of the patent, do not have more than five hundred employees;
- b) you are not an affiliate or otherwise owned by a large entity;
- c) you have not granted any ownership right or license or any other rights under your patent to a large entity.

Mr. Steven H. Rice  
June 14, 2002  
Page 2

If your status has changed to large entity, we must pay large entity fees at this point in order to prevent this patent from becoming declared invalid by the U.S. Patent Office. Please notify us promptly if this is the case.

Please indicate your instructions on the bottom portion of this letter and return it to us with your retainer. We will then proceed with the payment of the Issue Fee.

If you have any questions please don't hesitate to call me.

Sincerely,

  
Robert B. Hughes

RBH:cm  
Encl.



Mr. Steven H. Rice  
June 14, 2002  
Page 3

### INSTRUCTIONS

- ☐ Yes, "Small Entity" **does** apply.  
☐ Please attend to the payment of Issue Fee and the preparation of final drawings in application Serial No. 09/814,581. I have enclosed a **Small Entity retainer** in the amount of **\$1,726.00**.
- ☐ No, "Small Entity" **does not** apply.  
☐ Please attend to the payment of Issue Fee and the preparation of final drawings in Application Serial No. 09/814,581. I have enclosed a **Large Entity retainer** in the amount of **\$2,462.00**.
- ☐ I do NOT wish to proceed with the issuance of this patent. I understand this application will thus be deemed abandoned by the U.S. Patent and Trademark Office.
- ☐ Please charge \$\_\_\_\_\_ to my MasterCard or VISA per the following credit card information:

\_\_\_\_\_ MasterCard      \_\_\_\_\_ VISA      (Please check one)

Issuer: \_\_\_\_\_  
Card Number: \_\_\_\_\_  
Card Holder Name: \_\_\_\_\_  
Expiration Date: \_\_\_\_\_

Signed: \_\_\_\_\_ Date: \_\_\_\_\_

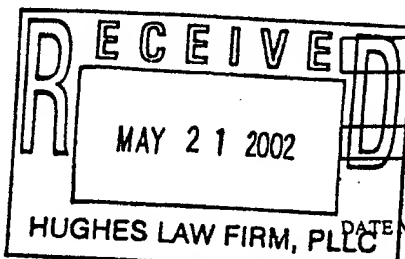


## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

## NOTICE OF ALLOWANCE AND FEE(S) DUE

22931 7590 05/16/2002  
ROBERT B. HUGHES  
HUGHES & SCHACHT, P.S.  
2801 MERIDIAN STREET  
SUITE 1  
BELLINGHAM, WA 98225-2412



EXAMINER	
HSIEH, SHIH YUNG	
ART UNIT	CLASS-SUBCLASS
2837	084-402000
DATE MAILED: 05/16/2002	

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,581	03/21/2001	Steven H. Rice	P313641	4528

TITLE OF INVENTION: METHOD AND APPARATUS FOR A DEVICE TO CREATE A MUSICAL NOISE

24313 8/2/02 2 wks. issue fee  
24314 7/16/02 4 mo. issue fee  
24315 9/16/02 cont. fee  
24316 8/16/02 3 mos. fml. drugs  
24317 8/16/02 issue fee due  
24318 10/16/02 issue Not due

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$640	\$300	\$940	08/16/2002

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

## HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above. If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

B. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

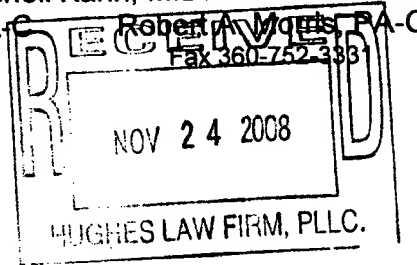
III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

ATTACHMENT B  
Serial Number 09/814,581  
Today's Date: January 6, 2009

**Bellingham Internal Medicine**  
2980 Squalicum Parkway, Suite #102  
Bellingham, Washington 98225-1880  
Mitchell Kahn, M.D.

Ellen Augustine, PA-C  
360-752-2956



Mr. Michael Hughes, Atty.  
Hughes Law Firm, PLLC  
4164 Meridian Street  
Bellingham, WA 98226

Re: Steven Rice

Dear Mr. Mr. Hughes,

Mr. Rice has asked that I write with specifics as to his care.

Mr. Rice has been under my care for at least the last 6 years for management of his pain due to an injury sustained in 1998. This has required daily opiates, physical therapy and, recently, referral to Swedish Pain Clinic.

Initially, it was felt that his pain was generating from his lower back but in the last few months new information has come to light that determined the principle pain generator is in his coccyx from a fracture sustained in 1998. Corticosteroid infiltration over the fracture site has temporarily resolved his symptoms and confirms diagnostically that this is the focus of his symptoms.

Whether or not he is a candidate for surgical intervention is yet to be determined and the reason for the Swedish Pain Clinic referral.

Mr. Rice also has mid-thoracic discomfort which typically does not require opiates and is not amenable to surgical intervention.

Hopefully, this information is helpful. Should you need further information, please feel free to call.

Cordially,

Robert A. Morris, PA-C